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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,689	10/13/2000	William J. Bussick	0112300/474	7705

29159 7590 07/30/2003

BELL, BOYD & LLOYD LLC  
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CHICAGO, IL 60690-1135

EXAMINER

JONES, SCOTT E

ART UNIT	PAPER NUMBER
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3713

20

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/687,689

Applicant(s)

BUSSICK ET AL.

Examiner

Scott E. Jones

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,9,10,12,13,15,17,19-23,25-32,34 and 35 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1-4,7,9,10,12,13,15,17,19-23,25-32,34 and 35 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment and request for continued examination filed on June 9, 2003 in which applicant amends claims 1, 17, 19, 20, 21, 22, 23, 31, 32, 34, and 35, and responds to the claim rejections. Claims 1-4, 7, 9-10, 12-13, 15, 17, 19-23, 25-32, and 34-35 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 9, 2003 has been entered.

### ***Claim Objections***

3. It is noted that claims 26, 28, and 30 recite "the Internet". While the term "Internet" is trademarked for goods and services, it is not presently trademarked for the service of a computer network. However, it is a term that is relative given both the rate at which technology is evolving, and misuse by modern media. The Internet is an infrastructure that supports the transmission of electronic data. It consists of all servers, routers, telephone lines, satellites, and other communications instruments used to convey electronic data, including Web sites, e-mail, usenets, and newsgroups, from one point to another. By using the term Internet, Applicant must be careful to delineate whether intending to claiming the infrastructure of the Internet, or use of the infrastructure. Furthermore, what is accepted as the conventional scope of the Internet today,

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in terms of infrastructure, is quite different from that which was accepted as briefly as five years ago, and it is unknown what will be accepted as the "Internet" of tomorrow. For these reasons, it is strongly urged that Applicant consider using more generic computer network terminology to claim the invention.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 7, 9-10, 12-13, 15, 17, 19-23, 31-32, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (U.S. 6,439,993).

O'Halloran discloses a method and apparatus for operating a gaming machine having a plurality of simulated spinning reels capable of displaying a wild card symbol at any of the reels.

Upon the appearance of a first wild card symbol, additional wild card symbols may appear, providing the player with additional opportunities to win a prize, or to win an additional prize.

O'Halloran discloses:

Regarding Claim 1:

- maintaining a list of award-yielding symbol combinations of said plurality of symbols in a controller (column 2, lines 36-40 and 48-51);

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- randomly generating on a plurality of paylines a first set of the symbols from the plurality of symbols (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing an award for each award-yielding symbol combination appearing in said first set on any of the paylines before any said symbol can be replaced (column 3, lines 18-30 and claim 3);
- selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each said selected symbol in the first set with one of the plurality of symbols to generate a second set of the symbols, the second set of symbols displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and
- providing an award for each award-yielding symbol combination appearing in said second set on any of the playlines even if said award yielding symbol combination in the second set appeared in the first set (column 3, lines 18-30 and claim 3).

Regarding Claim 2:

- the step of selecting at least one but not all of the symbols in the first set for individual replacement includes selecting at least one predetermined symbol for individual replacement (column 2, line 60-column 3, line 9, column 3, lines 18-30, and claim 3). O'Halloran replaces at least one predetermined symbol, that symbol being at least one non-wildcard or original symbol.

Regarding Claim 4:

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- the step of replacing the symbols includes individually replacing the selected symbols without spinning the reels (column 2, line 60-column 3, line 9, column 3, lines 18-30, and claim 3).

Regarding Claim 7:

- the first set of symbols and second set of symbols is part of a bonus game (column 2, line 60-column 3, line 9). The appearance of a first wild symbol in a combination is a trigger for and is inclusive to the bonus game which comprises replacing other non-wild card symbols with other wild card symbols for an additional prize amount.

Regarding Claims 9 and 15:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least one selected symbol (non-wild card symbol) in the first set, and wherein each wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 10:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for at least two selected symbols (non-wild card symbol) in the first set, and wherein each wild symbol sequentially functions as at least one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 12:

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- the step of replacing each selected symbol includes individually replacing one of the other symbols on a plurality of reels, wherein said symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claim 13:

- the step of replacing each selected symbol in the first set includes substituting a wild symbol for a plurality of symbols on one of said reels, wherein each said wild symbol functions as one of the plurality of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, and claim 3).

Regarding Claims 17, 19, 20, 21, and 22:

- maintaining in a controller of said gaming device a list of award-yielding symbol combinations of said plurality of symbols (column 2, lines 36-40 and 48-51);
- generating a first set of said symbols, wherein one of said symbols in said first set is a first wild symbol (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing an award for each award-yielding symbol combination appearing in said first set including any award symbol combinations that include the first wild symbol, the first wild symbol functioning as one of the other symbols to maximize the award yielding combinations (column 3, lines 18-30 and claim 3);
- selecting at least one but not all of the symbols in the first set except for the first wild symbol in the set for individual replacement and individually replacing each said selected symbol with a second wild symbol to create a second set of symbols



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that is displayed in place of the first set of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3); and

- providing an award for each award-yielding symbol combination appearing in said second set including any award yielding symbol combinations that include the first and second wild symbols, wherein the second wild symbol replaces another symbol and each of the first and second wild symbols function as one of the symbols to maximize the award yielding symbol combinations (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3).

Regarding Claim 23:

- maintaining in a controller of said gaming device a list of award-yielding playing card combinations (column 2, lines 36-40 and 48-51);
- generating a first set of playing cards, wherein one of said playing cards in said set is a wild card (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing an award for each award-yielding playing card combination in said first set including the wildcards which functions as one of the playing cards to maximize the award yielding combinations (column 3, lines 18-30 and claim 3).

Regarding Claims 31 and 34:

- randomly generating on a plurality of paylines a first set of (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);

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- providing a player an award for each award-yielding symbol combination appearing in said first set on any of the paylines (column 3, lines 18-30 and claim 3);
- selecting at least one but not all of the symbols in the first set for individual replacement and individually replacing each said selected symbol with one of the symbols to create a second set of symbols that is displayed in place of the first set of symbols (column 3, lines 18-30 and claim 3); and
- providing an award for each award-yielding symbol combination appearing in said second set on any of the paylines including all award yielding symbol combinations in the second set even if an award was provided for such award yielding combinations in the first set (column 3, lines 18-30 and claim 3).

Regarding Claims 32 and 35:

- generating a first set of symbols, wherein one of said symbols in said first set is a first wild symbol (abstract, figs. 1-5, column 2, lines 44-54, column 3, lines 18-30, and claim 3);
- providing an award for each award-yielding symbol combination appearing in said first set, wherein said wild symbol functions as one of the symbols to maximize the award yielding symbol combinations in said first set (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3);
- individually substituting a second wild symbol for at least one but not all of the symbols in said first set except for said first wild symbol to create a second set of

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symbols that is displayed in place of the first set of symbols (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3); and

- providing an award for each award-yielding symbol combination appearing in said second set, including each award yielding combination including said wild symbols and wherein each wild symbol functions as one of said symbols to maximize the award yielding symbol combinations in said second set (column 1, lines 31-44 and 48-54, column 2, lines 54-59, column 3, lines 18-30 and claim 3).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993).

O'Halloran discloses that as discussed above regarding claims 1, 2, 4, 7, 9-10, 12-13, 15, 17, 19-23, 31-32, and 34-35. O'Halloran seems to lack explicitly disclosing, regarding claims 25-30, the gaming device method is implemented via a data network. However, to one having ordinary skill in the art at the time of Applicant's invention, operating a gaming device over a network, whether the network is a LAN, WAN, or the Internet, was notoriously well known. One would be motivated to operate the gaming machine over a network such that a casino management system could monitor all monetary exchanges between the gaming machines and players.

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8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (U.S. 6,439,993) in view of Jaffe (U.S. 6,551,187).

O'Halloran discloses that as discussed above regarding claims 1, 2, 4, 7, 9-10, 12-13, 15, 17, 19-23, 31-32, and 34-35. O'Halloran seems to lack explicitly disclosing the step of individually replacing the symbols includes an animation of the symbols are replaced.

Jaffe, like O'Halloran, teaches of a gaming machine wherein wild symbols replace other symbols on winning or scattered paylines to provide a player an additional award. Therefore, Jaffe and O'Halloran are analogous art. Jaffe teaches of wild symbols that streak across the reels and hide behind the symbols they are replacing (figs. 5-16). It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Jaffe's animation symbol replacement feature in O'Halloran. One would be motivated to do so because there is a continuing need to develop new features to further enhance the level of player excitement offered by bonus games as Jaffe's streaking feature accomplishes.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-4, 7, 9-10, 12-13, 15, 17, 19-23, 25-32, and 34-35 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jaffe '432, Glasson '600, Tarantino '160, Last '380, and Wain '019 disclose gaming machines having symbol replacement.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael O'Neill, Acting SPE can be reached on (703) 308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

SEJ

sej

July 25, 2003



**MICHAEL O'NEILL  
PRIMARY EXAMINER**